

10-5-09 Lfm DAC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Ben-Aroya
Application No.: 10/595338
For: Apparatus and Method for Target Oriented Law
Enforcement Interception and Analysis
Filed: 4/10/2006
Examiner Not Yet Assigned
Art Unit: 3662
Confirmation No.: 7724
Customer No.: 27,623

Attorney Docket No.: 0005237USU/2279

Mail Stop Petitions

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Office of Petitions

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNAVOIDABLY UNDER 37 C.F.R. 1.137(a), OR IN THE
ALTERNATIVE, FOR AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Dear Sir:

A Notice of Abandonment was mailed on June 17, 2009 for failure to timely pay
the National Stage filing fees.

- NOTE: A grantable petition requires the following items:
- (1) Petition fee (to be charged to Deposit Account No.: 01-0467.
Fee to be determined by Office of Petitions);
 - (2) Terminal disclaimer with disclaimer fee - required for all
utility and plant applications filed before June 8, 1995, and

for all design applications; and

- (3) Statement that the entire delay was unavoidable or unintentional.

1. Petition fee

____ Small entity - fee \$____ (37 CFR §1.17(m))
____ Small entity statement enclosed herewith.
____ Small entity statement previously filed.

XXX Other than small entity - fee unintentional (**\$1620.00**) (C.F.R. § 1.17 (m)) **OR**
unavoidable (**\$540.00**) (37 C.F.R. §1.17(l))

2. Reply and/or Fee \$1584.00

A. The reply to the above-noted Office Action in the form of
____ (identify type of reply):
____ has been filed previously on ____
____ are enclosed herewith.

B. A firm check for \$____ covering the following fees:

- (1) \$____ Issue Fee
(2) \$____ for 10 advance copies of the patent; extension fee
(3) \$____ petition fee.
(4) \$ **1584.00** **National Stage filing fee**

____ has been paid previously on ____
____ is enclosed herewith.

XXX PLEASE CHARGE THE FEE OF \$1584.00 (NATIONAL STAGE FILING FEE) TO DEPOSIT ACCOUNT NO.: 01-0467 (IF APPLICATION IS REVIVED).

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d) of \$____ for a small entity or \$____ for other than a small entity) equivalent to the number of months from abandonment to the filing of this petition is enclosed herewith.

4. Verified Statement

Applicant hereby states that the entire delay in payment of the one thousand five

hundred eighty four dollars (\$1584.00) required National Stage filing fee from April 10, 2006 until the filing of this petition under 37 CFR 1.137(a) was unavoidable or 37 CFR 1.137(b) was unintentional.

Applicant hereby declares that all statements made herewith of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under section 1001 of Title 18 of the United States Code and that such willful false statement may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

XXX The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 which may be required with this communication or credit any overpayment, to **Deposit Account No. 01-0467**.

October 2, 2009

Date



Charles N.J. Ruggiero
Attorney for Applicant(s)

Registration No. 28,468

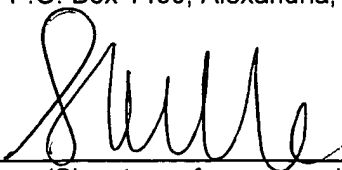
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, Connecticut 06901-2682
Telephone: (203) 327-4500
Telefax: (203) 327-6401

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Certificate No. **EM045443485US**, service under 37 CFR §1.10 and is addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Attention: Office of Petitions on October 2, 2009.

Suzanne Lombardo

(Typed name of person mailing paper)



(Signature of person mailing paper)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Ben-Aroya
Serial No.: 10/595338
Title: Apparatus and Method for Target Oriented Law Enforcement
Interception and Analysis
Filed: 4/10/2006
Examiner: Not Yet Assigned
Art Unit: 3662
Confirmation No.: 7724
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Mailstop PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**Petitions for Revival of an Application for Patent Abandoned
Unavoidably under 37 C.F.R. 1.137(a), or in the alternative, for an
Application for Patent Abandoned Unintentionally under 37 C.F.R.
1.137(b)**

Dear Sir:

A Notification of Abandonment was mailed on June 17, 2009.

10/06/2009 HBLANCO 00000027 010467 10595338
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Factual Background

Inventors Ben-Aroya et al., by and through their Israeli attorneys, filed International Application No. PCT/IL2006/000323 with the Israel Patent Office as Receiving Office (RO/IL) on March 12, 2006. Shortly thereafter, applicants' Israeli attorneys contacted United States attorneys at the firm of Smith, Gambrell & Russell LLP and instructed them to file a patent in the United States as soon as possible.

An attorney at Smith, Gambrell & Russell prepared documents for filing a patent application including 1) a national stage transmittal letter and 2) a certificate of mailing for a national stage application. As described below, the application was eventually filed electronically and neither of these documents were ever filed with the PTO.

The attorney at Smith, Gambrell & Russell also prepared an Oath or Declaration that did not claim priority to the aforementioned International Application. (See Oath or Declaration filed April 10, 2006.) Such an Oath or Declaration document that does not claim priority to an International Application is consistent with an Oath or Declaration for a U.S. Utility patent application and is inconsistent with an Oath or Declaration for a U.S. National Stage application.

On April 10, 2006, the attorney and a paralegal at Smith, Gambrell & Russell filed the instant patent application using PTO's Electronic Filing System-web ("EFS-web"). The EFS-web system had only recently been installed at Smith, Gambrell & Russell and neither the attorney nor the paralegal filing the application had yet received training on the system. Using the EFS-web system, the application was designated as a U.S. National Stage application under 35 U.S.C. § 371. (See EFS Acknowledgement Receipt dated April 10, 2006.) Neither a National Stage fee under 37 C.F.R. § 1.492(a), nor a Basic Utility Filing fee under 37 C.F.R. § 1.16(a)(1), nor any other fee was paid at the time of filing. *Id.*

Included in the documents filed on April 10, 2006 were 1) the aforementioned Oath or Declaration which did not claim priority to any International Application and 2) a petition to make special under 37 C.F.R. § 1.102(c). Both of these documents are consistent with a U.S. Utility application and are inconsistent with a U.S. National Stage application. See discussion, *supra*, and MPEP § 708.02(a)(I)(B) (stating that only utility or design applications filed under 35 U.S.C. 111(a) are eligible for petitions to make special.)

After filing the present application on April 10, 2006, the application was docketed at Smith, Gambrell & Russell as a U.S. National Stage application. Importantly, an electronic docket entry was created indicating September 12, 2008 as the deadline to pay the National Stage filing fee under 37 C.F.R. § 1.492(a). The September 12, 2008, date was electronically calculated as being 30 months after the filing of International Application No. PCT/IL2006/000323 on March 12, 2006. As discussed above, however, the Oath or Declaration filed with the application did not claim priority from International Application No. PCT/IL2006/000323.

On January 9, 2007, the PTO's Office of Petitions denied the Petition to Make Special filed on April 10, 2006. (See Petition Decision dated January 9, 2007.) As described above, the PTO's decision to act on the Petition to Make Special indicates that the PTO treated the application as a Utility application filed under 35 U.S.C. 111(a). See MPEP § 708.02(a)(I)(B).

After treating the application as a Utility application, however, the PTO failed to mail a "Notice to File Missing Parts" pursuant to 37 C.F.R. § 1.53(f), indicating that the applicants had failed to pay the Basic (Utility) Filing Fee, the Search Fee, and the Examination Fee.

Beginning on or about March 30, 2008, attorneys and agents of the law firm of Ohlandt, Greeley, Ruggiero & Perle, LLP ("the Ohlandt firm") attempted to contact the aforementioned attorney and paralegal at Smith, Gambrell & Russell to arrange to have

the file transferred to them pursuant to applicants' wishes. Such communications were directed to the e-mail accounts of the attorney and paralegal at Smith, Gambrell & Russell who had previously left the firm on or about June 1, 2007. Accordingly, such e-mail communications were not answered.

After several unsuccessful e-mail communication attempts, the Ohlandt firm filed a new Power of Attorney in the present case on July 28, 2008.

On September 1, 2008, an agent of the Ohlandt firm again sent an e-mail to the e-mail accounts of the already departed attorney and paralegal at Smith, Gambrell & Russell. On September 2, 2008, an agent of the Ohlandt firm sent the same communication by alternate means, a facsimile.

On September 3, 2008, this facsimile was acknowledged by a partner at Smith, Gambrell & Russell. The acknowledgement noted that applicants had requested the transfer of the file to the Ohlandt firm and that the filed Power of Attorney would mean that any future correspondence from the PTO would be directed to the Ohlandt firm. The acknowledgment further noted that the file would be sent to the Ohlandt firm promptly.

Following the acknowledgment, a transfer letter was prepared and the file was mailed to the Ohlandt firm that same day, September 3, 2008. Also, Smith, Gambrell & Russell's electronic docket entry for the file was closed out, including the entry for September 12, 2008 indicating that the National Stage filing fee was due. Accordingly, no electronic notifications were subsequently generated by Smith, Gambrell & Russell's docketing system for the present application.

The Ohlandt firm received the file on September 5, 2008.

Prior to receiving the file, on August 29, 2008, an agent of the Ohlandt firm, called the Office of Initial Patent Examination (OIPE) and spoke to a supervisor who transferred

the agent to the PCT help desk. Individuals at the PCT help desk indicated that they would help to accelerate the process and an email was sent to the pre-examination department. This individual also noted that a filing receipt had not yet issued and suggested a call back in one month (September 29, 2008).

On September 29, 2008, the Ohlandt firm again contacted OIPE and a further email was sent to the pre-examination department to accelerate the process to receive the Filing Receipt. Again on February 2, 2009, the Ohlandt firm contacted OIPE to determine the status of the application. No further information was received and a notice of abandonment was mailed from the USPTO on June 17, 2009. The Notice of Abandonment indicated that the application was abandoned for failure to meet the requirements of 35 U.S.C. 371 and 37 CFR 1.495 for failing to provide the full U.S. Basic National Fee by 30 months.

However, as noted earlier, the Oath or Declaration filed with the application did not claim priority from International Application No. PCT/IL2006/000323. The application was thus not filed under 35 U.S.C. 371, but instead was filed under 35 U.S.C. 111(a). Accordingly, after treating the application as a Utility application, however, the PTO failed to mail a "Notice to File Missing Parts" pursuant to 37 C.F.R. § 1.53(f), indicating that the applicants had failed

Petitions in the Alternative

Terminal Disclaimer with Disclaimer Fee: Since this application was filed on or after June 8, 1995, no terminal disclaimer is required.

I. Unavoidably abandoned U.S. National Stage application

Based on the foregoing factual background, applicants petition for a revival of the application as an unavoidably abandoned U.S. National Stage application pursuant to 37 C.F.R. § 1.137(a). Applicants have enclosed a petition fee of \$540 and National

Stage filing fees of \$1,584. Applicants are also filing herewith a Petition to Accept an Unintentionally Delayed Claim to Priority for failure to claim priority to International Application No. PCT/IL2006/000323.

II. Unintentionally abandoned U.S. Utility application

In the alternative, applicants petition for a revival of the application as an unintentionally abandoned U.S. Utility application pursuant to 37 C.F.R. § 1.137(b). Applicants have enclosed a petition fee of \$1,620 and Utility filing fees of \$1,584.

Applicants aver that the Oath or Declaration in the present application indicates that the application should have been treated as a Utility application rather than a U.S. National Stage application. Applicants further aver that the PTO's decision to decide on the merits applicants' Petition to Make Special indicates that the application was treated as a Utility application.

Applicants state and declare that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R.

§ 1.137(b) was unintentional and resulted from the failure to receive the Notice of Missing Parts from the PTO.

III. Unintentionally abandoned U.S. National Stage application

In the alternative, applicants petition for a revival of the application as an unintentionally abandoned U.S. National Stage application pursuant to 37 C.F.R. § 1.137(b).

Applicants have enclosed a petition fee of \$1620 and National Stage filing fees of \$1,584. Applicants have also enclosed a corrected Oath or Declaration claiming priority to International Application No. PCT/IL2006/000323.

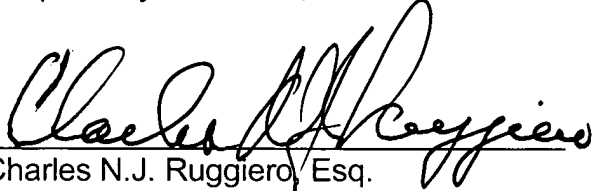
Applicants state and declare that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional.

Accordingly, reconsideration and withdrawal of the Abandonment in the present application are respectfully requested.

In view of the above facts, Applicants respectfully request that the above referenced application be revived.

Respectfully submitted,

October 2, 2009
Date


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